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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,238	09/28/2005	Hideto Kamimura	278507US0PCT	4244
22850	7590	05/01/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1797	
			NOTIFICATION DATE	DELIVERY MODE
			05/01/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/551,238	Applicant(s) KAMIMURA ET AL.	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/28/05 & 2/11/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3, 5-7, 11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suekuni (U.S. Pat. No. 6,335,310).

In column 1 lines 5-7, Suekuni discloses a conductive lubricant. In column 1 lines 58-64, Suekuni discloses that the lubricant comprises an ester base oil and from 0.1 to 5% by weight of an antistatic additive. In column 2 lines 51-64 Suekuni discloses that the ester base oil can be dioctyl sebacate, an ester as recited in claim 6, which has a viscosity and overlapping the ranges recited in claims 1-2, a viscosity index within the range recited in claim 1 and encompassing the range recited in claim 3, and a flash point of 215° C, within the range recited in claim 1. Dioctyl sebacate also meets the limitations of the diester of a dibasic acid and a monohydric alcohol of claim 7. While

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Suekuni does not explicitly disclose the volume resistivity of the composition, it is clear from column 1 lines 30-42 (where an oil with a resistivity of 1.2×10^9 ohm·cm is said to have a disadvantageously high resistivity) and the characterization of the lubricant as a conductive lubricant that the volume resistivity of the composition meets the limitation of claim 1. In column 3 lines 48-56, Suekuni discloses that the antistatic additive can be an amine derivative, as recited in claims 5 and 11. In column 2 lines 53-54 Suekuni discloses that the composition can contain an antioxidant, as recited in claim 14, and in column 1 lines 5-7 Suekuni discloses that the composition is a bearing oil, as recited in claim 15.

4. Claims 1-3, 6, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denpo (JP 2002-147477).

An English machine translation of Denpo, which is attached, has been used in setting forth this rejection. In paragraph 7, Denpo discloses a rolling device covered in a conductive lubricating oil with a volume resistivity below 1×10^7 ohm·cm, within the range recited in claim 1. In paragraph 10 Denpo discloses that the composition contains an antistatic agent. In paragraph 14, Denpo discloses that the lubricating oil can be an ester, as recited in claim 6, or an ether, as recited in claim 8. While Denpo does not specifically disclose the viscosity, viscosity index, pour point, or flash point of the lubricating oil, Denpo does disclose in paragraph 14 that the choice of lubricating oil is not particularly limited, and therefore implicitly discloses ranges of viscosities, viscosity indices, pour points, and flash points encompassing the claimed ranges.

5. Claims 1, 4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denpo in view of Egawa (JP 10-324883).

The discussion of Denpo in paragraph 4 above is incorporated here by reference. Denpo discloses a composition meeting the limitations of claim 8, but does not disclose specific suitable ethers.

An English translation of Egawa, which is attached, has been used in setting forth this rejection. Egawa, in paragraphs 6-7, discloses an ether base oil which meets the limitations of the ethers of claims 9-10 when n is 0 (claim 10), or 0-8 (claim 9). Egawa discloses that the viscosity index is 150 or more, within the range recited in claim 1, and that the pour point is less than -10° C, encompassing the range recited in claim 4.

It would have been obvious to one of ordinary skill in the art to use the ether of Egawa as the lubricating oil of Denpo as Egawa teaches that it is a suitable ether lubricating oil.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suekuni in view of Tagliamonte (U.S. Pat. No. 6,528,458).

The discussion of Suekuni in paragraph 3 above is incorporated here by reference. Suekuni discloses a composition meeting the limitations of claim 11, but does not disclose a composition further comprising a condensate of tetraethylenepentamine and a fatty acid.

In column 2 lines 28-34, Tagliamonte discloses a lubricating composition comprising a friction modifier. In column 8 lines 43-46 Tagliamonte discloses that a preferred friction modifier is the reaction product of tetraethylenepentamines and isostearic acid, meeting the limitations of the amine derivative of claim 12. While Tagliamonte discloses the compound as a friction modifier rather than an antistatic agent, the compound is capable of acting as an antistatic agent and therefore meets the limitations of claim 12. In column 9 lines 24-29, Tagliamonte discloses that the composition preferably comprises 0.25 to 0.75% by weight of the friction modifier, within the range recited for the amine derivative of claim 12. The addition of the tetraethylenepentamine/isostearic acid condensate of Tagliamonte to the composition of Suekuni therefore meets the limitations of claim 12.

It would have been obvious to one of ordinary skill in the art to include the tetraethylenepentamine/isostearic acid condensate of Tagliamonte in the composition of Suekuni, in order to adjust the frictional performance of the bearing being lubricated by the composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797